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PRE-APPEAL BRIEF REQUEST FOR REVIEW

Docket Number (Optional)

CURTIN 16

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on April 7, 2010Signature /Jana R. Williford/Typed or printed name Jana R. Williford

Application Number

09/747,937

Filed

2000-12-27

First Named Inventor

Steven D. Curtis

Art Unit

2621

Examiner

Helen Shibru

Applicant requests review of the final rejection in the above-identified application. No amendments are being filed with this request.

This request is being filed with a notice of appeal.

The review is requested for the reason(s) stated on the attached sheet(s).

Note: No more than five (5) pages may be provided.

I am the

☐

applicant/inventor.

☐

assignee of record of the entire interest.
See 37 CFR 3.71. Statement under 37 CFR 3.73(b) is enclosed.
(Form PTO/SB/96)

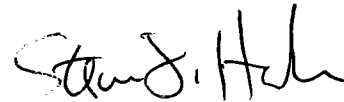
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attorney or agent of record.
Registration number 58,076

☐

attorney or agent acting under 37 CFR 1.34.

Registration number if acting under 37 CFR 1.34 _____



Signature

Steven J. Hanke

Typed or printed name

972-480-8800

Telephone number

April 7, 2010

Date

NOTE: Signatures of all the inventors or assignees of record of the entire interest or their representative(s) are required.
Submit multiple forms if more than one signature is required, see below*.

☒*Total of 1 forms are submitted.

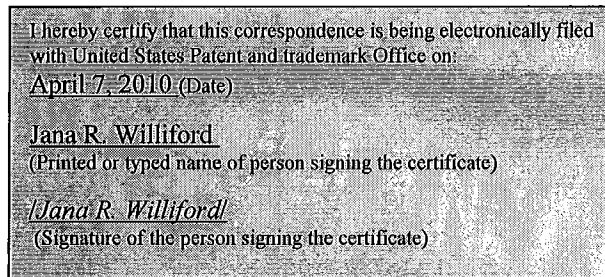
This collection of information is required by 35 U.S.C. 132. The information is required to obtain or retain a benefit by the public which is to file (and by the USPTO to process) an application. Confidentiality is governed by 35 U.S.C. 122 and 37 CFR 1.11, 1.14 and 41.6. This collection is estimated to take 12 minutes to complete, including gathering, preparing, and submitting the completed application form to the USPTO. Time will vary depending upon the individual case. Any comments on the amount of time you require to complete this form and/or suggestions for reducing this burden, should be sent to the Chief Information Officer, U.S. Patent and Trademark Office, U.S. Department of Commerce, P.O. Box 1450, Alexandria, VA 22313-1450. DO NOT SEND FEES OR COMPLETED FORMS TO THIS ADDRESS. SEND TO: Mail Stop AF, Commissioner for Patents, P.O. Box 1450, Alexandria, VA 22313-1450.

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant: Steven D. Curtis
Serial No.: 09/747,937
Filed: December 27, 2000
Title: ELECTRONIC WRITE PROTECT DETECTION FOR VIDEO TAPE RECORDERS
Grp./A.U.: 2621
Examiner: Helen Shibru Confirmation No.: 3480

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450



Sir:

PRE-APPEAL BRIEF REQUEST FOR REVIEW

The Appellant has carefully considered this application in connection with the Examiner's Final Rejection mailed January 8, 2010 (hereinafter "Office Action"), and respectfully requests a pre-appeal brief review of this application in view of the following remarks.

REMARKS/ARGUMENTS

The Appellant originally submitted Claims 1-22 in the application. In response to a previous Restriction Requirement, the Appellant withdrew Claims 2, 4, 8, 10, 12-13, 15, 17, 19-20, and 22. Accordingly, Claims 1, 3, 5-7, 9, 11, 14, 16, 18, and 21 are currently pending in the application.

I. Rejection of Claims 1, 3, and 5-7 under 35 U.S.C. §103

The Examiner has rejected Claims 1, 3, and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 5,936,786 to Go (hereinafter "Go") in view of U.S. Patent No. 5,877,906 to Nagasawa, *et al.* (hereinafter "Nagasawa"). The Appellant respectfully disagrees.

The Examiner recognizes that "claim 1 differs from Go in that the claim further requires the said deactivation occurring at or about a time of occurrence of said detection of said pre-existing signal" and cites portions of Nagasawa to cure this deficiency. (*See* middle of page 5 of Office Action.) Go teaches an apparatus and method to protect information recorded on a recording medium by determining blank portions of the recording medium where new information can be recorded. To accomplish this, Go explicitly teaches that the entire recording medium must be scanned to detect portions of the recording medium that already contain information (through the detection of a control pulse). The portions of the recording medium that do not have information stored on them (lack of a control pulse) are selected for recording of new information so that the new information is not recorded over existing information. Step 230 of Fig. 2 of Go teaches that "a blank portion on which new information may be recorded is selected from among the detected portions."

Go is explicit that the blank portion of the recording medium to be used for recording new information is "selected from among the detected portions." As such, the principle of operation of Go is to scan the entire recording medium to be able to select from among the detected portions. At the bottom of page 5 of the Office Action, the Examiner asserts "in light of the teaching in Nagasawa it would have been obvious...to modify Go by providing a deactivating operation at a time of detecting a pre-existing or pre-set signal in order to avoid loss of data." However, modifying Go to deactivate recording at the time of occurrence of the detected control pulse, thereby NOT scanning the entire recording medium, would change the principle of operation of Go.

MPEP §2143.01 states "If the proposed modification or combination of the prior art would change the principle of operation of the prior art invention being modified, then the teachings of the references are not sufficient to render the claims *prima facie* obvious. *In re Ratti*, 270 F.2d 810, 123 USPQ 349 (CCPA 1959). As such, the cited portions of the cited combination of Go and Nagasawa, as applied by the Examiner, do not establish a *prima facie* case of obviousness of independent Claim 1 and Claims that depend thereon. Accordingly, the Appellant respectfully requests the Review Panel to remove the §103(a) rejection of Claims 1, 3, and 5-7 and allow issuance thereof.

II. Rejection of Claims 1, 3, and 5-7 under 35 U.S.C. §103

The Examiner has rejected Claims 1, 3, and 5-7 under 35 U.S.C. §103(a) as being unpatentable over U.S. Patent No. 6,442,108 to Kurihara, *et al.* (hereinafter "Kurihara") in view of Go and further in view of Nagasawa. As established above, the cited portions of the cited

combination of Go and Nagasawa do not provide *prima facie* case of obviousness for independent Claim 1. Kurihara has not been cited to cure the above-noted deficiencies of the cited combination of Go and Nagasawa. As such, the cited portions of the cited combination of Kurihara, Go, and Nagasawa do not provide a *prima facie* case of obviousness for independent Claim 1 and Claims that depend thereon. Accordingly, the Appellant respectfully requests the Review Panel to remove the §103(a) rejection of Claims 1, 3, and 5-7 and allow issuance thereof.

III. Rejection of Claims 9, 11, 14, 16, 18, and 21 under 35 U.S.C. §103

The Examiner has rejected Claims 9, 11, 14, 16, 18, and 21 under 35 U.S.C. §103(a) as being unpatentable over Kurihara in view of Official Notice and further in view of Nagasawa. The Appellant respectfully disagrees.

The Examiner equates step S1-6 of Figure 6 of Kurihara with the limitation of detecting a pre-existing signal in pending independent Claim 9. (See Item 6, bottom of page 8 of the Office Action.) Assuming *arguendo* this to be true, Kurihara then teaches in step S1-8 activating recording of data on a recording medium when the pre-existing signal is detected. Claim 9, however, recites deactivating a record circuit when a pre-existing signal is detected. As such, the cited portion of Kurihara does not teach or suggest deactivating a record circuit upon detection of a pre-existing signal as recited in pending independent Claim 9.

Official Notice and Nagasawa have not been cited to cure the above-noted deficiencies of the cited portion of Kurihara but to teach that the pre-existing signal is a video signal and that the record circuit is deactivated at or about the time of occurrence of the detection of the pre-existing signal,

respectively. As such, the cited portions of the cited combination of Kurihara, Official Notice, and Nagasawa, as applied by the Examiner, do not provide a *prima facie* case of obviousness of pending independent Claim 9 and Claims that depend thereon. Accordingly, the Appellant respectfully requests the Review Panel to remove the §103(a) rejection of Claims 9, 11, 14, 16, 18, and 21 and allow issuance thereof.

IV. Conclusion

In view of the foregoing remarks, the Appellant sees all of the Claims currently pending in this application to be in condition for allowance and therefore earnestly solicits a Notice of Allowance for Claims 1, 3, 5-7, 9, 11, 14, 16, 18, and 21.

The Appellant requests the Reviewers to telephone the undersigned agent of record at (972) 480-8800 if such would further or expedite the prosecution of the present application. The Commissioner is hereby authorized to charge any fees, credits or overpayments to Deposit Account 08-2395.

Respectfully submitted,

HITT GAINES, PC

A handwritten signature in black ink, appearing to read "Steven J. Hanke".

Steven J. Hanke
Registration No. 58,076

Dated: April 7, 2010
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